UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,746	07/20/2001	Divya Chopra	DC3138 US NA	2433

23906 7590 11/06/2003

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1128
4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER	
BRUNSMAN, DAVID M	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 11/06/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/090,746	STERN ET AL.	
	Examiner	Art Unit	
	David M Brunsman	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) *21-34* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7, 9, 12, 15-20* is/are rejected.

7)☒ Claim(s) *8,10,11,13 and 14* is/are objected to.

8)☒ Claim(s) *1-34* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-20, drawn to a release coating composition, classified in class 106, subclass 127.

II. Claims 21-22, drawn to a process for coating, classified in class 264, subclass 145.

III. Claims 23-30, drawn to a release polymer film, classified in class 428, subclass 98+.

IV. Claims 31-34, drawn to a process for producing sheet molding, classified in class 264, subclass 241.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, such as one that does not require the coating to be applied to obtain the specific coating weight of 0.004lb/ream.

Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the

product as claimed can be made by another and materially different process, such as one that does not require the coating to be applied to obtain the specific coating weight of 0.004lb/ream.

Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have completely different functions.

Inventions I, III, and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of being used together, and they have different functions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation between Examiner Monica A. Fontaine and Bob Stevenson on 12 September 2003 a provisional election was made with oral traverse to prosecute the invention of group I, claims 1-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claims 1 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is unclear due to the inclusion of hydroxypropyl methylcellulose having a hydroxypropyl degree of substitution of 0. It would appear such a material would no longer be *hydroxypropyl* methylcellulose. Claim 3 is render indefinite in scope as the range "up to 3%" includes zero and the claim would thus read on solvent alone.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 5, 7 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4429120.

The starting material disclosed in example 1 of the reference teaches hydroxypropyl methylcellulose having a hydroxypropyl degree of substitution of 0.1-0.3 having a 2% aqueous viscosity of 4000cps. The composition of the instant claims is anticipated by the solution upon which viscosity is measured. Claims 18-20 are directed to the substrate employed in the intended future use and do not materially limit the composition of the instant claims.

Claims 1, 2, 4-7, 9, 12 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 3493407.

The reference teaches hydroxypropyl methylcellulose film forming compositions in aqueous alcohol (example 1) and water alone (example 2) comprising 10-30% HPMC having a 2% viscosity of 2-7 cps and a hydroxypropyl substitution of 0.15-0.30. The reference envisions addition of a pigment (column 3, line 38). The addition of a minor amount of pigment is considered to encompass 0.01-1.5%. Claims 18-20 are directed to the substrate employed in the intended future use and do not materially limit the composition of the instant claims.

Claims 8, 10, 11, 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record fails to teach or suggest compositions similar to the instant claims containing finely divided silica or talc. Prior art such as the tape joint compositions of US Patent 5039341 would appear to be unable to function as release compositions and therefore excluded from the instant claims. The prior art of record fails to teach or suggest the improved properties obtained by use of 1-35% alcohol.

The mere failure of a reference to disclose all the advantages asserted by applicant is no a substitute for actual differences in properties. In re DeBlauwe, 222 USPQ 191. An apparently old composition cannot be converted into an unobvious one simply by the discovery of a characteristic one cannot glean form the cited prior art. Titanium Metals Corp. v. Banner, 227 USPQ 773.

Accordingly, the burden of proof is upon applicant to show that the instantly claimed subject matter is different form and unobvious over that taught by the prior art relied upon. In re Brown, 173 USPQ 685, 689; In re Best, 195 USPQ 430; In re Marosi, 21 USPQ 289, 293.

Any evidence to be presented under 37 C.F.R. 1.131 or 1.132 should be submitted before final rejection in order to be considered timely. It is anticipated that the next office action will be a final rejection.

Any foreign language documents submitted by applicant have been considered to the extent the short explanation of significance, English abstract or English equivalent allow.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Brunsman whose telephone number is 703-308-3454. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

David M Brunsman
Primary Examiner
Art Unit 1755

DMB